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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,204	09/08/2000	Charles A. Eldering	T723-00	3450

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
2003 SOUTH EASTON RD
SUITE 208
DOYLESTOWN, PA 18901

EXAMINER

RAMAN, USHA

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/658,204

Applicant(s)

ELDERING, CHARLES A.

Examiner

Usha Raman

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 25-32, 34, 53, 61-63 and 70.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 3-30-06
13. ☐ Other: _____.



CHRIS KELLEY

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2600

Response to Arguments

1. Applicant's arguments filed May 12th, 2006 have been fully considered but they are not persuasive.

Applicant traverses rejection under 35 USC 112, first paragraph, stating that the specification provides support for the feature of "...downloading [of EPG] can be actuated by the subscriber". The examiner respectfully disagrees with the conclusions applicant has arrived at in an attempt to provide support for the claimed limitations. The claimed limitation recites "*downloading can be actuated by the subscriber*". In applicant's first attempt to cite support in the specification, applicant claims that "a subscriber has the ability to turn the STB on", and therefore "actuates the download of the EPG screens". However, the specification does not disclose that the "turning on of the STB" itself is actuated by the subscriber, let alone that the subscriber turns on the STB for the purpose of downloading an EPG. Even if the subscriber actuated the turning on of the STB, the subscriber is not actuating the downloading of the EPG – the downloading of the EPG is merely a result of a series of step followed after the turning on of the STB. In applicant's second attempt to cite support in the specification, the applicant claims that, "by a subscriber indicating that he or she is a user having a profile different from the currently loaded profile, the subscriber actuates the download of the customized EPG for the new/altered profile". However, the cited portions provided by the applicant (page 16, lines 16-21 of the disclosure, indicate that the EPG screens are preloaded (i.e. already downloaded) at the STB, wherein the appropriate screen is displayed upon selection

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by the user. The cited portion fail to teach that EPG screens download is actuated by the user. In a third attempt, applicant states that, "actuation maybe based on subscriber preferences, which include subscriber indicating that he desires the download of a new EPG". While support have been provided stating that download of EPG screens maybe based on preferences of the user, the specification fails to disclose that a subscriber indicates in the subscriber preferences that he desires the download of a new EPG. As a result, the examiner maintains the new matter rejection.

Applicant argues that, "Ellis does not disclose customizing EPG at subscriber node, instead Ellis teaches customizing EPGS at a program guide client that is implemented on user television equipment". In its broadest reasonable interpretation, a subscriber node is understood by the office to be the connection at the subscriber premises equipment. If applicant believes subscriber node should be interpreted differently, applicant is requested to amend the claims to add limitations describing the subscriber node.

Applicant argues that, "Ellis fails to teach that a second EPG is downloaded to the subscriber interface in response to a detected change in the subscriber characterization". The examiner respectfully disagrees. Ellis discloses that EPG is customized according to user preference and history. See Ellis: [0111] and [0116]. In particular the program guide server creates personalized viewing recommendations or filters listing based on viewing history obtained. In presenting the personalized recommendation or filtered listing, a second EPG is downloaded to

the subscriber interface in response to a detected change in the subscriber characterization.

Applicant further argues that “Macrae teaches associating hard pages with ads” not “associating each EPG of the plurality with a set of ads” and that, “a hard page is not EPG”. The examiner respectfully disagrees. A hard page as described by Macrae, is a EPG screen, wherein the EPG screen is targeted with advertisements relating to the screen. The hard page is similar to the “EPG screens” disclosed by the applicant, wherein a customized EPG screen is downloaded at the subscriber equipment. See applicant’s disclosure, page 12, lines 2-5 and page 13, lines 10-12.

Applicant finally argues that Macrae and Ellis are not combinable because “customization of ads correspond to contradictory items”. The examiner respectfully disagrees. Ellis teaches customization based on user’s viewing habits and preferences, while Macrae teaches customization based on a channel currently tuned to. For example, a user might be generally interested in watching movies of a particular genre, but when the user turns into a network broadcasting sports, an advertisement related to user’s preferences as well as the channel tuned into may be presented. The combination teaches targeting advertisements using yet another factor. Furthermore, Macrae has been primarily relied upon for teaching a plurality of customized EPG screens. As a result, the rejection has been maintained.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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